

REMARKS

Claims 1-24 were examined and reported in the Office Action. Claims 1-6 are rejected. Claim 1 is amended. Claims 1-24 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 103(a)

It is asserted in the Office Action that claims 1-6 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 6,363,357 issued to Rosenberg et al. ("Rosenberg"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, "[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*." Further, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).

Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007). Additionally,

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Applicant’s amended claim 1 contains the limitations of “registering a client and a service with a broker” (see Applicant’s page 5, paragraph [0016], lines 1-8, Fig. 2); and the at least one attribute of the client differs in data type from the at least one attribute of the service, and when the at least one attribute of the client and the at least one attribute of the service have differing contexts, the comparison is made on a case-by-case basis” (see Applicant’s page 2, paragraph 10, lines 4-7 and page 3, paragraph [0011], lines 1-5).

Rosenberg discloses a method of selling a digital content product online where the digital content is reproduced a predetermined number of times. In Rosenberg, communication is established between a buyer computer and a broker computer so that the broker computer accounts for cost associated with a corporate rate and authorizes the buyer to purchase a predetermined number of copies of digital content by sending a product key to the buyer computer.

Distinguishable from Rosenberg, Applicant’s amended claim 1 includes the limitations of “the at least one attribute of the client differs in data type from the at least one attribute of the service, and when the at least one attribute of the client and the at least one attribute of the service have differing contexts, the comparison is made on a case-by-case basis” (Applicant’s claim 1; see Applicant’s page 2, paragraph 10, lines 4-7 and page 3, paragraph [0011], lines 1-5). Nowhere in Rosenberg is it taught, disclosed or

suggested that attributes of a buyer and merchant differ in data type or that a comparison is made on a case-by-case basis when at least one attribute of the client and at least one attribute of the service have differing contexts. Thus, Applicant's amendments to claim 1 are distinctive from Rosenberg.

Additionally, the assertions made in the Office Action on page 2 that lead to a conclusion of obviousness are not explicit as required by MPEP 2142 and the basic requirements of an articulated rationale under MPEP 2143 cannot be found (see also *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) "noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit."). Additionally, since Rosenberg does not teach, disclose or suggest all the limitations of Applicant's amended claim 1, as listed above, Applicant's amended claim 1 is not obvious over Rosenberg in view of no other prior art since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claim 1, namely claims 2-6, are also not obvious over Rosenberg in view of no other prior art for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claim 1-6 is respectfully requested.

CONCLUSION

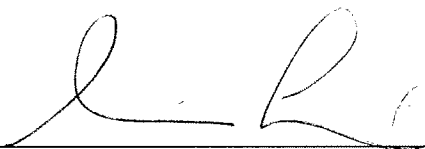
In view of the foregoing, it is submitted that claims 1-24 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

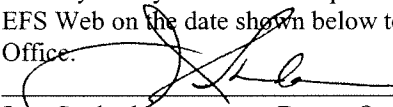
Dated: October 23, 2007

By: 
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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Jean Svoboda

Date: October 23, 2007